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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,205	11/09/2001	William T. Wilkinson	WIL-102US	3554
31344	7590	07/01/2004	EXAMINER	
RATNERPRESTIA P.O. BOX 1596 WILMINGTON, DE 19899			PARDO, THUY N	
			ART UNIT	PAPER NUMBER
			2175	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/007,205	WILKINSON, WILLIAM T.
	Examiner	Art Unit
	Thuy Pardo	2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 November 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-21 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/05/02, 4/24/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Applicant's Application filed on November 09, 2001 has been reviewed.
2. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Magid US Patent Application No. 2001/0032144.

As to claim 1, Magid teaches the invention substantially as claimed, comprising:
providing a comprehensive, centralized network of service provider members [sellers, 0029 of page 2], each member having expertise in at least one facet of IP commercialization [sellers and purchasers who make use of the network central to market intellectual property, 0033 of pages 2-3];
offering an interested party access to the network [see fig. 2; 0041-0046 of pages 3-4];
and

members of the network providing services to the interested party [offer the purchaser a full disclosure of the technology, 0058 of page 4; 3-7 of fig. 2].

As to claim 2, Magid teaches the invention substantially as claimed. Magid further teaches collecting data relating to at least said one aspect of IP [inherent in the system]; and disseminating said data to at least said interested party [3-6, 3-7 of fig. 2].

As to claim 3, Magid teaches the invention substantially as claimed. Magid further teaches ranking information identifying, classifying, comparing, ranking and evaluating one or more IP assets, entities that own or control IP, or sources of IP, and the method further comprises compiling said ranking information [0013 of page 1].

As to claim 4, Magid teaches the invention substantially as claimed. Magid further teaches using said ranking information to recognize innovation by presenting awards to top ranked entities [0014 of page 1].

As to claim 5, Magid teaches the invention substantially as claimed. Magid further teaches that the interested party is also a member of the network [using username and password in order to enter the system, fig. 2b].

As to claim 6, Magid teaches the invention substantially as claimed. Magid further teaches that the members of the comprehensive network comprise inventors, government

entities, research and development (R&D) and manufacturing entities, IP specialists, providers of business services, and IP marketplace providers [0014 of page 1].

As to claim 7, Magid teaches the invention substantially as claimed. Magid further teaches that the services provided by the network comprise one or more services in the group consisting of prior art search services; legal services; financial services; prototyping services; model making services; manufacturing; testing services; industrial design services; commercial art services; marketing services; IP valuation services for assigning tangible value to IP assets; IP audit services; services that provide R&D project analysis, evaluation, or both; insurance services, security analysis services; and management consulting services [0034 of page 3].

As to claim 8, Magid teaches the invention substantially as claimed. Magid further teaches creating a financial market for IP assets where IP assets, or securities based upon IP assets, can be bought and sold [0043 of page 3].

As to claim 9, Magid teaches the invention substantially as claimed. Magid further teaches providing a certification program for certifying IP analysts qualified to provide tangible valuation of IP assets [0045-0065 of pages 3-5].

As to claim 10, Magid teaches the invention substantially as claimed. Magid further teaches providing an educational program comprising education in accounting, financial, legal,

and actuarial skills for educating individuals how to provide tangible valuation of IP assets [0034 of page 3].

As to claim 11, Magid teaches the invention substantially as claimed. Magid further teaches providing a trade show in which a plurality of the service providers exhibit information to others about the services offered by the service providers [0007-0013 of page 1].

As to claim 12, Magid teaches the invention substantially as claimed. Magid further teaches the facet of IP commercialization in which each member has expertise corresponds to a step in a natural life cycle of an IP asset, the trade show having a physical layout organized with the service providers grouped together according to step in the IP asset life cycle [see fig. 2].

As to claim 13, Magid teaches the invention substantially as claimed. Magid further teaches that the service providers are grouped into legal service providers, business service providers, pre-market service providers, commercialization service providers, and after-market service providers [inherent in the system].

As to claim 14, Magid teaches the invention substantially as claimed. Magid further teaches a dedicated marketplace for buying, selling, auctioning, and bidding on IP assets [fig. 2].

As to claims 15-17, all limitations of these claims have been addressed in the analysis above, and these claims are rejected on that basis.

As to claim 18, Magid teaches the invention substantially as claimed. Magid further teaches that the access to the network is provided by means of a global computer network or by telephone [0031-0033 of pages 1-2].

As to claim 19, Magid teaches the invention substantially as claimed. Magid further teaches providing a dedicated site on the global computer network accessible by the interested party; providing computerized means for digitally receiving a request for information about one or more service provider members from the interested party; providing a database of records relating to the service provider members searchable by the computerized means in response to the request for information; and providing the requested information to the interested party [fig. 2; 0031-0033 of pages 2-3].

As to claim 20, Magid teaches the invention substantially as claimed. Magid further teaches receiving characterizing information pertaining to the interested party, and matching a service provider member to the interested party based upon the characterizing information [fig. 2].

As to claim 21, Magid teaches the invention substantially as claimed. Magid further teaches information selected from the group consisting of type of IP about which the interested party desires the information, subject area of the IP, and the geographic region of the interested party [0014 of page 1].

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy Pardo, whose telephone number is (703) 305-1091. The examiner can normally be reached Monday through Thursday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached at (703) 305-3830.

The fax phone number for the organization where this application or proceeding is assigned are as follows: (703) 872-9306 (Official Communication)

and/or:

(703) 746-5616 (***Use this Fax#, only after approval by Examiner, for “INFORMAL” or “Draft” communication. Examiner may request that a formal/amendment be faxed directly to then on occasions.***)

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

5. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

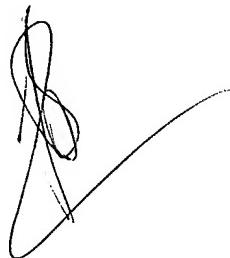
(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5359, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

June 24, 2004



THUY N. PARDO
PRIMARY EXAMINER